



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,217	08/24/2000	David F Broadbent	437312000400	4405

7590 06/18/2003

Robert V Racunas Jr Esq
Kirpatrick & Lockhart LLP
Henry W Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/645,217

Applicant(s)

BROADBENT ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 101 because the claimed invention is not being in the technological art.

As to claims 1-3 and 5-6, simply stating in the preamble that the method is computer implemented is not enough to place the invention in the technological art. As to technological art recited in the preamble, mere recitations in the preamble (i.e. intended or filed of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract unless there is positive recitation in the claim as to a whole to breathe life and meaning into the preamble. In present case, none of the recited steps are directed to anything in the technological art as explained above with the exception of the recitation in the preamble that the method is "computerized". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that computer performs the recited steps. Therefore, the preamble is taken to merely recited a field of use.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3621

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dykstra et al., U. S. Patent 5,611,052 in view of Anderson et al., U. S. Patent 6,209,095.

As to claim 1, Dykstra teaches a computer implement method for generating a set of required procedures for processing a mortgage loan comprising the acts of (abstract):

- a) Receiving a request to process a mortgage loan (column 4 lines 12-40 and Fig. 2A);
- b) Generating a plurality of tasks, the tasks comprising actions required to process the mortgage loan (Figs. 2A-2F);
- c) Distributing one or more of the tasks to one or more systems capable of performing one or more of the tasks (column 3 line 33 – column 4 line 11 and Figs. 1-2A).

Dykstra does not specifically teach the plurality of tasks including tasks required by federal or state law. However, this matter is taught by Anderson as processing mortgage loan application, and said application is designed to be complied with mortgage lending regulations (column 10 lines 65-67 and Fig. 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the mortgage processing method of Dykstra to include the feature of the requiring mortgage application process to be complied with the mortgage lending regulations for preventing illegal loan transactions.

As to claim 2, monitoring completion of the plurality of tasks whereby a report of completion of all required tasks can be generated is taught by Dykstra as generating a report when the loan process is completed (Fig. 2A).

As to claim 3, Dykstra teaches authenticating a person submitting the request to process a mortgage loan (Figs. 2A-2B).

As to claim 4, Dykstra teaches electronically transferring the plurality of tasks required to process the loan to an electronic loan processing workflow engine for controlling and managing execution of the tasks (Figs. 1-2A).

As to claim 5, the plurality of tasks required to process the mortgage loan are based upon mortgage loan related laws and regulations comprising Federal, State, local and professional regulations and requirements and implementing instructions relating to mortgage loan processing is taught by Dykstra modified by Anderson as processing mortgage loan application, and said application is designed to be complied with mortgage lending regulations (see claim 1 above).

As to claim 6, producing a completion certificate is taught by Dykstra as generating a report when the loan process is completed (Fig. 2A).

As to claim 9, selected vendors are automatically notified by the compliance engine to perform a task and to report task completion to the compliance engine is taught by Dykstra as selected vendors (i.e. credit bureau) are automatically notified by the Direct Lending CPU to perform a task and to report task completion to the Direct Lending CPU (column 4 line 41 – column 5 line 12 and Figs. 1-2A).

Claims 7-8 and 10-17 are rejected for the similar reasons as claims 1-6.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sinclair (U. S. Patent 6,208,979) discloses selectively matches credit applicants with money lenders through a global communications network.

DeFrancesco, Jr. et al. (U. S. Patent 6,505,176) discloses a workflow management system automatically coordinates the workflow among various workgroups and entities involved in the credit application process. The steps and rule tests that define an organization's workflow are customized according to the workflow requirements and process steps for each organization.

Lent et al. (U. S. Patent 6,567,791) discloses for presenting a reason for the rejection of a credit application from an applicant.

Peter (JP 06301706 A) discloses providing a data processing system calculates the optimum value of combinations of a loan, a revised limit amount of a credit loan, postponement of installment payment.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

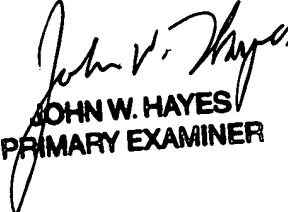
The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
June 11, 2003


JOHN W. HAYES
PRIMARY EXAMINER